

**PATENT APPLICATION**

**RESPONSE UNDER 37 CFR §1.116  
EXPEDITED PROCEDURE  
TECHNOLOGY CENTER ART UNIT 3628**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masamichi TAKAHASHI et al.

Group Art Unit: 3628

Application No.: 10/762,471

Examiner: A. ROBINSON-BOYCE

Filed: January 23, 2004

Docket No.: 118462

For: EVALUATION APPARATUS AND EVALUATION METHOD

**REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the March 12, 2009 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-18 are pending in this application.

Claims 1-7, 9-12 and 14-18 are rejected under 35 U.S.C. §103(a) over U.S. Patent Pub. No. 2007/0226628 to Schlack in view of U.S. Patent Pub. No. 2004/0103058 to Hamilton. The Office Action also rejects claims 3, 8 and 13 under 35 U.S.C. §103(a) over Schlack and Hamilton, and further in view of JP 2003-085347 to Masamichi et al. These rejections are respectfully traversed.

The rejection of independent claims 1, 6 and 11 lacks merit for two reasons. First, Hamilton does not properly qualify as prior art against this application, as cited in the Office

Action. Second, even if Hamilton is prior art, it does not disclose the recited "evaluation unit."

The current application claims priority to two priority documents (JP 2003-017022 and JP 2003-324272). JP 2003-017022 was filed on January 27, 2003, which predates Hamilton's non-provisional filing date. A verified translation of JP 2003-017022 is enclosed with this Response. JP-2003-017022 supports the subject matter of the instant claims. A breakdown of where support is found for the claims is found in the appendix attached to this Response. Thus, this application is entitled to a filing date preceding the non-provisional filing date of Hamilton.

However, Hamilton does claim priority from two provisional applications that were filed before January 27, 2003. But under U.S. patent law, Hamilton only be cited as prior art if the provisional applications support the portions of the published reference cited against us. Applicants respectfully submit that the provisional applications of Hamilton fail to disclose the recited evaluation unit.

Independent claims 6 (used as illustrative of independent claims 1, 6 and 11) recites a step of "calculating a strength of influence and an extent of influence, for each of the groups, based on the activities, the concepts, or the groups, or any arbitrary combination thereof" (emphasis added). The Office Action concedes that Schlack does not disclose this feature. Rather, the Office Action asserts that Hamilton discloses an Analytic Network Process 130 that incorporates dependencies and feedback.

However, both the provisional and non-provisional Hamilton applications do not disclose calculating a strength of influence and an extent of influence of groups of people, based on the recited criteria. Rather, Hamilton relates to allowing a business to decide what service or product to offer. An analysis of Hamilton, using the language of the provisional application allows a better illustration of this point. Applicants note that the text of the

provisional applications govern the allowable interpretation of the non-provisional application, as the non-provisional application is not entitled to an interpretation unsupported by the provisional application.

Consider provisional application 60/407,550 ("the '550 application"). The '550 application best sums up the intended purpose on page 3, stating the vast majority of IT management models do not answer "effectiveness questions," such as "which service should we improve and how?" See '550 application, page 3. The overarching purpose of the '550 application is to provide a system capable of integrating a vast array of information and considerations to allow an answer to the above question. During the course of this process the system uses an Analytical Network Process (ANP). This ANP (identified as element 130 in the non-provisional application) is cited by the Office Action as analogous to the recited "evaluation unit" of claim 1.

The ANP "involves building a networked set of relationship of decision elements." See '550 application, page 6. The '550 application goes on to explain the ANP checks the extent of influence of elements on other elements. The '550 goes on to define what some elements may be. For example, page 8 discusses that the system must identify the objective, possible actions, fixed constraints (i.e. budgets), and numerous "criteria." These criteria may include available resources, efficiency, impact, and benefits. See '550 application, page 8, list item 4.

As careful examination of these various elements shows that they relate to business concepts such as how a budget limitation will in turn influence available resources to solve a problem. The '550 application does not relate to determining the influence of groups of people within the company. The closest the '550 application come to evaluating people relates to identifying the "person or role from whose perspective the problem must be solved is known." See '550 application, page 8, list item 2. But this element does not relate to the

influence of that person on others. Rather, item 2 only relates to the identification of the person.

Provisional application 60/409,728 relates to the influence of groups of people even less, as it discusses the management of security systems. Thus, based on the two provisional applications it becomes clear that the appropriate interpretation of Hamilton does not disclose or suggest the features of claims 1, 6 and 11. Furthermore, any interpretation of Hamilton to the contrary is not supported by the provisional applications.

For at least the above reasons, the rejection of claims 1, 6 and 11 lacks merit. Thus, withdrawal of the rejection of claims 1, 6 and 11, and claims 2-5, 7-10 and 12-18 depending therefrom, is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Moshe K. Wilensky  
Registration No. 56,263

JAO:MKW/jfb

Attachments:  
Appendix  
Verified Translation of JP 2003-017022

Date: June 12, 2009

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 320850**  
**Alexandria, Virginia 22320-4850**  
**Telephone: (703) 836-6400**

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## APPENDIX

### Relationship between claim 1 and JP '022

◆ Claim 1

Claim	JP '022
An evaluation apparatus for evaluating activities of a plurality of groups to be evaluated, the apparatus comprising:	
A survey unit configured to inquired directly to the groups concerning activities performed by the groups, each of the activities include one or more concepts,	Paragraphs 0044, 0076 to 0079
Wherein the survey unit is configured to aggregate plural responses received from the groups into survey result information;	Paragraphs 0040, 0076 to 0079
a survey result storing unit configured to store the survey result information;	Paragraph 0044
an analysis and evaluation unit having a concept analysis unit and an evaluation unit,	The analysis and evaluation unit 346 paragraphs 0060 to 0069,
wherein the concept analysis unit is configured to examine activity data included in the survey result information, to perform an analysis of the concepts that are used fro the activities by the groups, and to generate concept data representing a common concept shared by the groups, and	Paragraphs 0055, 0057, 0067 to 0069 Fig. 14
the evaluation unit is configured to calculate a strength of influence and an extent of influence, for each of the groups, based on the activities, the concepts or the groups, or any arbitrary combination thereof.	Paragraphs 0060 to 0066

◆ Claims 2 to 5

Support for claims 2 to 5 of this application are found, for example, in claims 2 to 5 of JP '022.

◆ Claim 16

Support for claims 16 of this application is found, for example, in paragraphs 0044, 0060 to 0066 and 0076 to 0079 of JP '022.